FILE COPY

Office Supreme Court, U.
JAN 10 1936

IN THE

Supreme Court of the United States

OCTOBER TERM, 1935.

No. 356.

WINE RAILWAY APPLIANCE COMPANY, *Petitioner*,

v.

ENTERPRISE RAILWAY EQUIPMENT COMPANY, *Respondent*.

On Certiorari to the United States Circuit Court of Appeals for the Sixth Circuit.

REPLY BRIEF FOR PETITIONER.

GILBERT P. RITTER,
CHARLES W. OWEN,
Attorneys for Petitioner.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

INDEX.

Page

The Two Notices Provided For By Section 4900 R. S. Are Not Alternative Notices of Infringement. One Is A Notice To The Public That The Patented Article Is Patented 1

IN THE

Supreme Court of the United States

OCTOBER TERM, 1935.

No. 356.

WINE RAILWAY APPLIANCE COMPANY, *Petitioner*,

v.

ENTERPRISE RAILWAY EQUIPMENT COMPANY, *Respondent*.

On Certiorari to the United States Circuit Court of Appeals for the Sixth Circuit.

REPLY BRIEF FOR PETITIONER.

The Two Notices Provided For By Section 4900 R. S. Are Not Alternative Notices Of Infringement. One Is A Notice To The Public That The Patented Article Is Patented.

As Point 1 of its argument, the respondent contends that

> "Section 4900 R. S. shows by its terms that it requires notice of infringement in one of the alternative methods provided as a prerequisite to the recovery of damages." (Brief, p. 5)

In the discussion of this point respondent's brief makes the following statements (italics ours) which clearly bring out the nature of its contention:

P. 7:

> "Every patent owner or licensee can give individual notice of *infringement*, one of the alternative methods provided, without trouble or expense."

Pp. 7-8:

> "The requirement of the statute is to give notice of the accusation of *infringement*. Copying an article marked patented is of itself such notice. But mere knowledge of the existence of a patent is not notice of *infringement*."

P. 8:

> "That the purpose of the statute is to provide for notice of *infringement* is clear * * *."

And respondent summarizes its argument on this point as follows:

> "To summarize this section of the brief: By the plain language of the statute the duty to give notice of *infringement* is imposed without limitation upon 'all patentees, and their assigns and legal representatives'." (page 9)

From the foregoing, respondent's contention is seen to be that:

Section 4900 R. S. requires, as a prerequisite to the recovery of profits and damages, that the infringer be notified of his *infringement*; and it provides alternative methods for giving notice of infringement, namely, either (1) to the public as a whole by marking the article "patented", or (2) to the infringer individually by special and actual notice.

It is clear to the point of demonstration that this contention of the respondent is based on a misunderstanding of the statute and that it cannot be sustained.

1. The statute provides for two, and only two, notices. One is a notice that a particular article is *patented*; the other is a notice that an *infringement* has been committed. In the words of the statute, one of these notices is a "notice to the public that the same is *patented*"; as to the other notice the statute employs the words "notified of the *infringement*".

These two notices unquestionably are of distinctly different import. Obviously, to give notice that an article is *patented* is not to give notice that *infringement* has been committed. It is therefore incorrect to say that Section 4900 R. S. provides alternative methods of giving notice of infringement.

2. Not only does Section 4900 R. S. not provide alternative notices of infringement, but by its plain terms no patentee, assignee or legal representative is required to give any notice whatsoever of infringement to an infringer unless there has been a failure to mark patented articles with the notice of patenting which the statute specifies they shall bear. The duty the statute places upon all patentees and their assigns and legal representatives is only "to give sufficient notice to the public that the same (a patented article made or vended) is *patented*" by marking the article "patented". The duty of giving notice of *infringement* to an infringer, as a condition precedent to the recovery of damages, is expressly limited by the statute to a "party failing so to mark".

Manifestly a non-manufacturing patentee is not a "party failing so to mark". Until an article which is capable of being marked comes into existence no duty to mark can arise; and obviously there can be no failure to mark unless an article which has been made has not been marked.

3. Respondent urges (brief, p. 8) that "The purpose of the statute is to provide for notice of infringement." That statement is true to the extent only that the statute provides for notice of *infringement* in case there has been failure to mark the patented article "patented" so as "to give sufficient notice to the public that the same is *patented*".

The *purpose* of Section 4900 R. S. clearly is to guard the public against unwitting infringement. Its purpose plainly is (1) to prevent innocent infringement by requiring patented articles to bear a notice indicating that they are patented, and (2) to save the infringer harmless in respect to damages accruing prior to actual notice of the infringement, if the patentee (or other person having rights under the patent) has invited innocent infringement by failing to mark the required notice of patenting on articles which have been made or vended under the patent

GILBERT P. RITTER,
CHARLES W. OWEN,
Attorneys for Petitioner.